

REMARKS

The examiner rejected claims 1-4 based on the combination of U.S. Patent No. 4,866,958 to Bretl et al. and U.S. Patent No. 6,522,253 to Saltus. At an October 26, 2004 interview with the examiner and the primary examiner, the examiners expressed a concern that the element of the “indicia” was recited in the original independent claims 1 and 4 in terms of its intended use. It is believed that the proposed amendment addresses and satisfactorily alleviates this concern and distinguishes over the prior art cited by the examiner in the Office Action.

The Industry’s Struggle to Solve a Problem and Applicant’s Solution Generated Commercial Success

By way of background, the field of this invention is solving the problem of unlocked airline baggage and how to have security and non-intrusiveness (people’s luggage not being broken into and destroyed) at the same time. In approximately late 2002 the Transportation Security Administration (“TSA”) announced that it would open airline baggage and recommended to passengers that they not lock their luggage. This actually created a new security problem, that of unlocked baggage that can be subjected to a bomb. In addition, airline travelers feared damage to their luggage and this problem caused a dramatic loss of sales of locks and a jump in damaged luggage claims.

Applicant’s solution was to a problem that the travel industry struggled to solve. See letter from Travel Pro attached as exhibit A to declaration of David Tropp. Applicant’s solution was found to be innovative and Applicant has received significant

orders for his special lock pursuant to the method of the present invention and has entered into an agreement with the TSA to work with his special lock pursuant to that method.

Applicant's Solution

Applicant's solution is a method of improving airline luggage inspection by making such inspection secure yet non-intrusive. The method, as worded consistent with the proposed amendment, includes making available to consumers both a special lock having a combination lock portion (or generally a first lock portion) and a master key lock portion, the master key lock portion for receiving a master key that can open the master key lock portion of any special lock of this type, the special lock designed to be applied to an individual piece of airline luggage, and an indicia associated with the special lock that matches an indicia previously provided to the luggage screening entity, which special lock the luggage screening entity has agreed to process in accordance with a special procedure. The method also includes marketing the special lock to the consumers in a manner that conveys to the consumers that the special lock will be subjected by the luggage screening entity to the special procedure. Finally, the method includes the luggage screening entity acting pursuant to a prior agreement to look for the indicia while screening luggage and, upon finding said indicia on an individual piece of luggage, to use the master key previously provided to the luggage screening entity to, if necessary, open the individual piece of luggage without breaking into the individual piece of luggage.

Independent Claims 1 and 4 As Amended Do Not Add New Matter

Independent claims 1 and 4 as modified by the proposed amendment and as described above do not add any new matter, although phrases have been added to the

claim to replace the words “conveying to luggage purchasers and to the luggage screening entity that the special lock is a lock that the luggage screening authority has agreed not to break, and providing the luggage screening authority, directly or indirectly, with the access to the master key, said access being exclusive except for a manufacturer of said master key and/or a provider of the special lock to airline travelers and/or a provider of the master key to the luggage screening authority” . The changed wording is explicitly or implicitly inherent in the patent application as filed.

For example, it is implied in the patent application that an indicia that matches the indicia (on or associated with the special lock) was previously provided to the luggage screening entity. Furthermore, the application at page 7 line 4 and page line lines 1-2 states explicitly that the luggage screening entity “agrees that locks having such indicia will not be broken into” and that the luggage screening entity will not have to clip the locks with such indicia. See also pages 6 and 7 of the patent application and generally at pages 6-9 thereof, explicitly stating that the indicia conveys to the consumers that the luggage screening entity has agreed not to break the special lock. It is apparent that the luggage screening entity could not have agreed to such a thing unless the luggage screening entity previously had the indicia and agreed to use it, that is unless the luggage screening entity was previously provided with an indicia that matched the indicia on the special lock.

Likewise, from the fact that page 7 line 4 of the patent application explicitly states that the luggage screening entity “agrees that locks having such indicia will not be broken into” it is also explicitly if not inherently in the patent application that the luggage screening entity previously (previous to actual screening) agreed that when screening

luggage having the indicia it would process the luggage in accordance with a special procedure. The procedure whereby its workers would determine if the luggage has that indicia and, upon finding it, use the master key previously provided to it to avoid breaking the luggage is in fact a special procedure that differs from the previous normal procedure of breaking into the luggage whenever it is necessary to open the luggage.

Furthermore, the patent application also explicitly states in many places including page 6 lines 17-19 that the indicia conveys to consumers that the special lock is a lock that the luggage screening entity has agreed not to break. If, for example, the indicia includes wording on the special lock stating “approved by the TSA” that the consumers see at the point of sale, an example illustrated in the drawings and described in the specification, then the “conveying to consumers” occurs with at least some kind of marketing, either from the consumers seeing the special lock or more likely from packaging of the special lock at the point of sale or from additional advertising or explaining by the vendor. It is thus inherent in the patent application that the special lock is marketed to the consumers in a manner that conveys to them that the special lock will be subjected to the above special procedure.

Finally, the last step recited in the claim of “the luggage screening entity acting pursuant to a prior agreement to look for the indicia while screening luggage and, upon finding said indicia on an individual piece of luggage, to use the master key previously provided to the luggage screening entity to, if necessary, open the individual piece of luggage and not try to break into the individual piece of luggage” is explicit or inherent in the application. As previously stated, the application explicitly states that the indicia conveys to consumers that the luggage screening entity has agreed to “recognize” the

indicia and not break the special lock or luggage containing it. If so, it is implicit or inherent that the luggage screening entity is acting pursuant to a previous agreement when it looks for the indicia and, if it finds it, uses the master key and does not break into the luggage. Furthermore, the patent application states explicitly that a master key will be provided to the luggage screening entity so that it can open and not have to break into luggage having the indicia. Accordingly, the last step of the claim is also not new matter.

Applicant's Solution is Distinguishable Over The Prior Art in a Nonobvious Way

The prior art cited by the examiner, Bretl and Saltus, do not address, let alone solve, the above problem of unlocked baggage. Bretl teaches the idea of the special dual lock and suggests that a back-up master key be provided to supervisory or security personnel where the padlock is used for school lockers. The prior art does not teach or suggest a method of luggage inspection by a luggage screening entity that includes making available to consumers a special lock and an indicia matching an indicia previously provided to the luggage screening entity, which special lock the luggage screening entity has agreed to process in accordance with a special procedure, marketing the special lock to the consumers in a manner that conveys to the consumers that the special lock will be subjected to the special procedure, and the luggage screening entity acting pursuant to a prior agreement to look for the indicia while screening luggage and, upon finding it on an individual piece of luggage, to use a master key previously provided to the luggage screening entity to, if necessary, open the individual piece of luggage and not try to break into the individual piece of luggage.

It is respectfully submitted that the above steps are nonobvious and distinguishable over the prior art.

Although this conclusion should be clear, it is also strengthened by the evidence of applicant's solution to the industry's "open baggage" problem achieving commercial success as an innovative solution.

Thus the present invention goes way beyond using a special lock on luggage. This solves a serious problem in an innovative manner.

Independent claims 1 and 4 have been further modified in the proposed amendment to recite broader language concerning the special lock's relationship to the indicia. Proposed claims 1 and 4 recite "the special lock also having an indicia associated therewith" rather than "the special lock also having indicia thereon". The patent application discloses an embodiment wherein the indicia is on the special lock (see, e.g., page 6 of patent application at the 5th line of the Detailed Description). This disclosed embodiment is only one way of having the indicia be associated with the special lock. Thus the patent application supports this amendment.

In addition, some minor changes were made to the wording of the claims 1 and 4. Independent claims 1 and 4 have been slightly modified at line 4 thereof to eliminate unnecessary words that make the claim harder to read. In each of claims 1 and 4, at line 4 of the claim the words "the special lock" in the phrase "the special lock having a combination ..." is repetitious and unnecessary and has been deleted. Similarly, in a later part of that phrase, the word "having" in the phrase "having a master key lock portion" is also unnecessary and has been deleted.

For clarity, the term "luggage screening authority" has been changed to "luggage screening entity" since the patent application at page 8 lines 17-20 states that luggage screening authority broadly encompasses non-governmental entities.

New claim 5 and 7 have been added to recite the simple embodiment wherein the indicia is located directly on the special lock. New claim 5 is dependent on independent claim 1 and new claim 7 is dependent on independent claim 4. New claim 6 is dependent on new claim 5 and recites the additional element recited in claim 3.

Finally, new independent claim 8 is identical to independent claim 1 and new independent claim 9 is identical to independent claim 4 except in both cases that the word "matches" in claims 1 and 4 has been changed to "corresponds with" in line 8 of new claims 8-9. "Corresponds with" is broader than "matches" but one way for the indicia to correspond with one another is for them to match. Thus, this change is supported by the specification.

For consistency, this change in claims 8 and 9 in turn necessitates the following further changes: (i) that the word "indicia" be changed to "corresponding indicia" in line 8 of new claims 8 and 9 when referring to the indicia previously provided to the luggage screening entity and (ii) that the phrase "indicia" and "said indicia" in the last paragraph of these claims had to be changed to "corresponding indicia" and "said corresponding indicia".

Thus the instant amendment is understood to place the claims 1 through 9 in condition for allowance and it is respectfully requested that the amendment be entered. It is therefore respectfully requested that the examiner allow claims 1-9 as amended.

A check for \$44 has been included for the fourth independent claim (since two new independent claims have been proposed to be added).

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Respectfully submitted,



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